

REMARKS

Claims 11-12 are pending in the present application. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of July 17, 2006, the following actions were taken:

(1) Claims 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,795,794 to Winnik et al. (hereinafter "Winnik") in view of U.S. Patent No. 3,776,757 to Eastman et al. (hereinafter "Eastman").

It is respectfully submitted that the presently pending claims be examined and allowed.

Rejection Under 35 U.S.C. § 103 over Winnik in view of Eastman

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the USPTO has not satisfied the requirement for establishing a case of *prima facie* obviousness in the rejections of claims 11 and 12.

In the communication dated March 7, 2006, the Examiner asserted that the disclosure in Winnik of an alkyl (meth)acrylate constituted a teaching of an unsaturated monomer having a convertible moiety in hydrophobic form according to the present invention. Applicant reasserts the argument presented in the response filed June 12, 2006, i.e. that the disclosure in Winnik does not teach the presently claimed invention.

Applicant's claims expressly require an unsaturated monomer containing a convertible moiety in hydrophobic form. Therefore, the present claims recite not only monomer containing a convertible moiety, but also the particular state that the moiety must occupy to prepare the recited polymer particles. In contrast, the disclosure makes no mention of the actual state of the alkyl moiety. In the instant application, for a reference to remedy the present claims obvious, it must teach not only an unsaturated monomer containing a convertible moiety, but also the particular state of the convertible moiety. Winnik—the sole reference the Examiner has offered as providing this teaching—does not provide the particular state of the alkyl moiety of the (meth)acrylate disclosed therein. Furthermore, this state is not obvious from the Winnik disclosure, which contains no suggestion regarding the hydrophobicity or hydrophilicity of the polymer toner particles or their constituent monomers. Therefore, Winnik alone does not provide sufficient detail to anticipate the present claims or render them obvious.

The Eastman reference is not asserted as remedying this failure. Rather, the Examiner has offered the Eastman reference as rendering obvious the addition of quite a different element of claims 11-12, i.e. the conversion of a convertible moiety from a hydrophobic form to a hydrophilic one. Further, the Applicant respectfully asserts that the combination of Winnik in view of Eastman does not establish a *prima facie* case of obviousness against the present invention, because these references lack a suggestion or motivation for making such combination, and further, this rejection is reconstructed using impermissible hindsight.

The Examiner has asserted that it is “within the purview of” one skilled in the art to combine the teachings of Eastman with Winnik and that one would be “motivated by the reasonable expectation of success” to do so. Applicant asserts that even if true, this alone does not establish a *prima facie* case of obviousness as set forth in the MPEP. As stated above, an asserted motivation to combine references must be based in a teaching or suggestion found in the references themselves or in knowledge generally available to those skilled in the art. Absent this, the mere combinability of the references or the expected success of such a combination is insufficient to establish a *prima facie* case. MPEP 2142. Likewise, an assertion that a combination lies within the capabilities of one skilled in the art is also insufficient without an objective reason to make the combination. *Id.* at 2143.01. As stated

above, Winnik makes no suggestion regarding the hydrophobicity or hydrophilicity of the moieties of monomers disclosed therein. Likewise, and not surprisingly, Winnik also does not suggest that said moieties can or should be converted from one state to the other upon formation of the particles, as the claim language sets forth. Eastman does teach that such a conversion may be accomplished via modification of pH; however, it lacks a teaching or suggestion to employ such a step on the particles of Winnik to achieve the present invention. Applicant submits that, in citing Winnik and Eastman, the Examiner has not demonstrated a reason to combine these references that is not based on hindsight, and therefore has not established a *prima facie* case of obviousness based on such a combination. Applicant further asserts that, since the references are not properly combinable, the polymer of the present invention is patentable over the polymer of Winnik in that the claimed process allows the creation of an amphipathic polymer particle through polymerization absent interference from hydrophilic moieties, followed by conversion to a more useful hydrophilic state after formation.

To be clear, the Applicant understands that method steps in product-by-process claim do not render the product patentable merely because the process is novel. The product *per se* must be novel. However, the product claimed using the enumerated process produces a composition that is fundamentally structurally different than that which would be formed without the process steps. Specifically, the claimed invention allows for formation of a particle under very favorable hydrophobic conditions (without the disrupting influence of hydrophilic groups), and then allows for conversion to occur which generates hydrophilic groups at the surface of the formed particle. The prior art does not disclose such particles. Applicant therefore respectfully requests that this rejection be withdrawn.

CONCLUSION

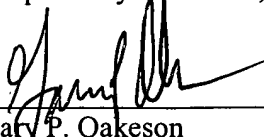
In view of the foregoing, Applicants believe that claims 11-12 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is

invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 17th day of October, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gary P. Oakeson", written over a horizontal line.

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